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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,404	09/24/2003	Viacheslav A. Petrov	UC0318 US NA	5035

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E I DU PONT DE NEMOURS AND COMPANY
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WILMINGTON, DE 19805

EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/669,404

Applicant(s)

PETROV, VIACHESLAV A.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-9 are pending.

Claims 1-9 are rejected.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanechika et al. (US 5,547,593).

Sanechika et al. disclose a lubricant oil composition comprising a compound (A), having the claimed compound structure and a compound (B), which the Examiner considers to be equivalent to the applicants claimed organic active material (see entire disclosure, in particular column 4, line 33 to column 5, line 64; column 35, line 34 to column 38, line 23; column 43, line 6 to column 44, line 41; compounds S4, S8, S12 and S13 in columns 55, 57 and 58; examples 17-20 in column 67 and Table 5 ; and example 29 in column 69 and 70).

4. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Kamal et al. (Tetrahedron Letters, Vol 43, No. 41, August 2002, pp. 7353-7355).

Kamal et al. teach the synthesis of fluoroalkyl aryl ethers having the claimed structural formula (see entire disclosure, in particular Scheme 1 and Table 1 on page 7354).

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5. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasushi et al. (Patent abstracts of Japan, publication number 06-293691), for the reasons given in the previous office action, mailed November 26, 2004.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farbwerke Hoechst A. G. (GB 1230932), for the reasons given in the previous office action, mailed November 26, 2004.

Double Patenting

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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10. Claims 1-4 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of copending Application No. 10/669,403. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 5 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/669,403. Although the conflicting claims are not identical, they are not patentably distinct from each other because CF₂CF₂H of claim 5 in the instant application, is an Rf substituent within the meaning of Rf of copending Application No. 10/669,403 and the organic active materials disclosed in claim 9 of the instant application are organic active materials within the definition of the active material of copending Application No. 10/669,403 (see page 3, lines 1-7 of copending Application No. 10/669,403).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Amendment

Claim Objections

13. The objection to claim 2 is withdrawn.

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Claim Rejections - 35 USC § 112

14. The rejection of claims 1-8 under 35 U.S.C. 112, second paragraph, is withdrawn.

Claim Rejections - 35 USC § 102

15. The rejection of claims 1- under 35 U.S.C. 102(b) as being anticipated by Kamal et al. (Tetrahedron Letters, Vol. 43, No. 41, August 2002, pp. 7353-7355) is withdrawn, since the claims now require a solution comprising an organic active material and a compound having the claimed structure.

16. The rejection of claims 1-5 under 35 U.S.C. 102(b) as being anticipated by Farbwerke Hoechst A. G. (GB 1230932) is withdrawn, since the claims now require a solution comprising an organic active material and a compound having the claimed structure.

Claim Rejections - 35 USC § 103

17. The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Farbwerke Hoechst A. G. (GB 1230932) is withdrawn, since the claims now require a solution comprising an organic active material and a compound having the claimed structure.

Response to Arguments

Rejection of claim 6 under 35 U.S.C. 102(b) as being anticipated by Kamal et al. (Tetrahedron Letters, Vol 43, No. 41, August 2002, pp. 7353-7355)

18. Applicant's arguments filed March 28, 2005 have been fully considered but they are not persuasive.

The Applicant argues that Kamal et al. do not disclose the claimed compounds. The Examiner disagrees. See Scheme I, wherein R is C₂H₅O, X is F and Y is H; and Table I, entry I. Note the Examiner believes that the addition of the extra O and the omission of the H atom in

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the compound of entry I is a typo based upon the information given in Scheme 1. The correct product formula for entry I should be $4\text{-C}_2\text{H}_5\text{O}_2\text{C}_6\text{H}_4\text{OCF}_2\text{CF}_2\text{H}$. This rejection is maintained.

Rejection of claims 7 and 8 under 35 U.S.C. 102(b) as being anticipated by Yasushi et al.

(Patent abstracts of Japan, publication number 06-293691)

19. Applicant's arguments filed March 28, 2005 have been fully considered but they are not persuasive because m can be 0 in claims 7 and 8 and the fluorinated compound is a liquid crystal ingredient used for the liquid crystals display components of electronic devices. This rejection is maintained.

Rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Farbwerke Hoechst A.

G. (GB 1230932)

20. Applicant's arguments filed March 28, 2005 have been fully considered but they are not persuasive.

The Applicant's argue that the chemical fields for plant protective agents and dyes are highly unpredictable. However, the Applicant's have not presented any evidence showing that these chemical fields are highly unpredictable. Thus, the Examiner considers this argument to be based upon the Applicant's opinion and not factual evidence. This rejection is maintained.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

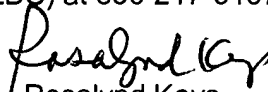
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-TR 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalynd Keys
Primary Examiner
Art Unit 1621

June 10, 2005